

REMARKS

Applicants wish to thank the Examiner for the consideration given this case to date. Applicants have now had an opportunity to carefully consider the Examiner's Action, and respectfully submit that the application, as amended, is now in condition for allowance. Originally, claims 1-10 were filed with this application. Claims 2, 4, and 8-10 are presently canceled. Claims 1, 3, and 5-7 are presently amended. Claims 11-26 are new. The claim amendments and new claims add no new matter to the application. Claims 1, 3, 5-7, and 11-26 are pending in this application.

THE EXAMINER'S ACTION

In the Office Action dated October 5, 2004, the Office:

- objected to claims 9 & 10 based on informalities;
- rejected claims 1-10 under 35 U.S.C. 112, second paragraph, as being indefinite;
- rejected claims 1-7 under 35 U.S.C. 102(b)/103(a) as anticipated by or, in the alternative, as obvious over Nagase et al. (U.S. Pat. No. 5,395,812; "Nagase");
- rejected claim 8 under 35 U.S.C. 102(b) as anticipated by Nagase;
- rejected claim 9 under 35 U.S.C. 102(b) as anticipated by Langner et al. (U.S. Pat. No. 5,817,855; "Langner"); and
- rejected claim 10 under 35 U.S.C. 102(b) as anticipated by Armor et al. (U.S. Pat. No. 4,469,816; "Armor").

CLAIM OBJECTIONS

The Patent Office objected to informalities in claims 9 and 10. Claims 9 and 10 have been canceled, rendering the objections moot.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Patent Office rejected claims 1-10 as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. More specifically, the Office stated that there were generally no limitations in the claims reciting structure of the composition or, if limitations were present, they were unclear. Additionally, the Office noted

that references to specific drawings in certain of the claims do not particularly point out the properties of the claimed compositions.

Applicants have canceled claims 2, 4, and 8-10, rendering rejections of those claims moot. Applicants have also amended claims 1, 3, and 5-7 to recite additional limitations. More specifically, Applicants have added one or more limitations concerning the structure of the compositions (e.g., grain size, crystallographic strain, purity) in amended claim 1, in new claims 18 and 21, all of which are independent claims, and in at least one dependent claim (e.g., claim 19). These claim amendments are believed to overcome the claim rejections and put the claims in condition for allowance.

REJECTIONS UNDER 35 U.S.C. §§ 102(B)/103

The Patent Office rejected claims 1-7 as anticipated by or, in the alternative, as obvious over Nagase. Specifically, the Office noted product-by-process limitations in certain of the claims and stated that patentability of a product does not depend on its method of production.

Applicants respectfully disagree with the Office and point to MPEP 2113 and a case referenced therein, *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979). *In re Garnero* holds that process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where, for example, the process would be expected to impart distinctive structural characteristics to the final product. As Applicants have discussed above, example properties like one or more of, grain size, crystallographic strain, and purity, distinguish the claimed compositions from the prior art. However, as discussed above, Applicants have amended claims and added new claims that include limitations in one or more of the properties including, for example, grain size, crystallographic strain, and purity. Accordingly, it is believed that the claim rejections are overcome and that the claims are in condition for allowance.

REJECTIONS UNDER 35 U.S.C. § 102(B)

The Patent Office rejected claims 8, 9, and 10, as anticipated by Nagase, Langner, and Armor, respectively.

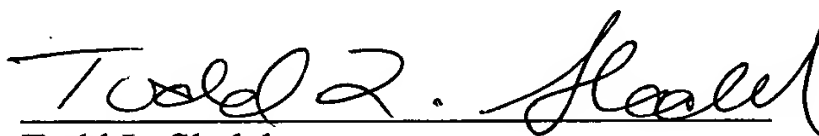
Applicants have canceled claims 8-10, rendering the claim rejections moot. Applicants additionally note that these claim rejections were generally based on what the Office has said are lack of limitations to the compositions in the claims. Applicants again note that specific limitations concerning the claimed compositions have been added to certain of the claims through amendment or through the addition of new claims. Accordingly, it is believed that the claims are in condition for allowance

CONCLUSION

For the foregoing reasons, Applicant respectfully asserts that this case is now in a condition for allowance and respectfully requests notification of such allowance. No fees are believed due other than the fee for a two-month extension of time and for one additional claim. If additional fees are believed due, the Commissioner is hereby authorized to charge the additional fees, or credit any overpayment, to Deposit Account No. **02-2051**, referencing Attorney Docket No. **24961-5**.

Respectfully submitted,

Dated: March 7, 2005



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